Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK A. WEISS

Appeal No. 2003-1146
Application 09/595,249

HEARD: 20 November 2003

Before JERRY SMITH, FLEMING and BLANKENSHIP, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-44, which constitute all the claims in the application.

The disclosed invention pertains to a method and apparatus for automatically creating a print job which conforms to the print job specifications of a client.

Representative claim 1 is reproduced as follows:

1. An automated computer-implemented method of comparing a job quote for a

print job with production data for a print job that is related to the job quote, the job quote being stored in an electronic file and containing a plurality of estimate-related specifications, the production data being stored in an electronic document, the method comprising:

(a) entering the estimate-related specifications of the job quote file into a comparison engine;

(b) analyzing the production data to determine its actual specifications;

(c) entering at least some of the actual print job specifications into the comparison engine; and

(d) in the comparison engine, comparing the estimate-related specifications to the entered actual print job specifications, and outputting any discrepancies therebetween.

The examiner relies on the following references:

Brovman	4,655,135	Apr. 07, 1987
Freedman	4,839,829	June 13, 1989
Feeman et al. (Feeman)	5,735,941	Apr. 07, 1998
Crandall et al. (Crandall)	5,963,641	Oct. 05, 1999
Inoue et al. (Inoue)	6,273,535 B1	Aug. 14, 2001 (filed Feb. 10, 1998)

The following rejections are on appeal before us:

1. Claims 1-7, 10-13, 23-29 and 32-35 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the disclosure of Freedman.

2. Claims 8 and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Freedman in view of Feeman.

3. Claims 9 and 31 stand rejected under 35 U.S.C. § 103(a) as being

unpatentable over the teachings of Freedman in view of Brovman.

4. Claims 14, 15, 17-22, 36, 37 and 39-44 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Crandall in view of Freedman.

5. Claims 16 and 38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Crandall in view of Freedman and further in view of Inoue.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of anticipation and obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon does not support the rejection of any of the claims on appeal. Accordingly, we reverse.

We consider first the rejection of claims 1-7, 10-13, 23-29 and 32-35 under 35 U.S.C. § 102(b) as being anticipated by the disclosure of Freedman. Anticipation is

established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived by appellant [see 37 CFR § 1.192(a)].

With respect to independent claim 1, the examiner has indicated how he finds the claimed invention to be anticipated by Freedman [answer, pages 4-5]. Appellant argues that in the Freedman process, the estimate-related specifications never exist simultaneously with the actual print job specifications, and, therefore, there can never be a comparison of these two quantities. Appellant argues that the examiner improperly equates the design template of Freedman with the claimed estimate-related specifications and the inserted graphic with the claimed actual print job specifications [brief, pages 14-15]. The examiner responds that the actual print job specification corresponds to the requester's specifications entered into the template, and the estimate-related specifications correspond to the rules that govern how to print a job.

Therefore, according to the examiner, the estimate-related specifications exist simultaneously with the actual print job specifications in Freedman [answer, pages 17-19]. Appellant responds that there is no preexisting production data in Freedman, and therefore, step (b) is completely absent from Freedman and the comparison of step (d) cannot be formed. Appellant also asserts that the examiner's correlations of the template to actual print job specifications and the rules with the estimate-related specifications are incorrect [reply brief, pages 1-4].

Before the merits of this rejection can be determined, one must understand exactly what is being claimed. Claim 1 essentially recites the comparison of estimated-related specifications of the job quote with actual print job specifications which are determined from analyzing the production data. Since these terms do not have explicit or implicit meanings, we look to the specification for help in understanding these terms. The production data is the actual contents that a client wishes to have printed and is stored in an electronic document. A print job is also the product desired by the client, and actual print job specifications refer to this production data [specification, page 5]. Therefore, the claimed actual print job specifications represent the actual specifications of the product desired by the client as represented in an electronic document. The job quote is defined as the specifications that describe the desired print job, and these specifications are also stored in an electronic file [Id.]. This definition appears to suggest that the job quote is the product that the company plans to print based on the

perceived requirements entered by the client. Therefore, the estimate-related specifications of the job quote would be the specifications of the product that the company plans to create based on the company's perception of the product desired by the client. Based on these definitions, we view claim 1 as claiming the comparison of the specifications defining the product that the company plans to create (the job quote) with the specifications actually desired by the client (the actual print job specifications) and to indicate any discrepancies between these two quantities.

Claim 1 clearly requires that some of the actual print job specifications be available for comparison based on the production data which has been stored as a PDF file. The production data as used in claim 1 is not met by the templates of Freedman because these templates do not yield the actual contents desired by the client nor do they result in an electronic document stored as a PDF file. Appellant is correct that there is no disclosure in Freedman that production data as defined in appellant's specification exists in Freedman or that actual print job specifications of this production data as defined in appellant's specification are ever available for comparison as recited in claim 1. Since we agree with appellant that Freedman fails to disclose every feature of claim 1, we do not sustain the rejection of claim 1. Since claims 2-7 and 10-13 depend from claim 1, we also do not sustain the examiner's rejection of these claims.

Independent claim 23 has recitations similar to claim 1. Accordingly, we also do not sustain the examiner's anticipation rejection of claim 23 or of claims 24-29 and 32-

35 which depend therefrom.

We now consider the various rejections under 35 U.S.C. § 103. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the

relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). As noted above, only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived by appellant [see 37 CFR § 1.192(a)].

With respect to claims 8 and 30, the examiner added the teachings of Feeman to Freedman to teach the use of bleed as a comparison parameter. With respect to claims 9 and 31, the examiner added the teachings of Brovman to Freedman to teach the use of ink coverage as a comparison parameter [answer, pages 8-10]. Appellant argues that neither Feeman nor Brovman teaches the claimed comparison [brief, page 18].

We will not sustain the examiner's rejection of claims 8, 9, 30 and 31. As noted above, the comparison of estimate-related specifications and actual print job specifications is not taught by Freedman. Feeman and Brovman are only cited to show that bleed and ink coverage were known parameters that are used in specifying a printed product, and they do not overcome the deficiencies of Freedman noted above.

We now consider the rejection based on the teachings of Crandall and

Freedman. With respect to independent claim 14, the examiner essentially finds that Crandall teaches the claimed invention except for the automatic selection of the type of printing equipment being used. The examiner cites Freedman as teaching this feature. The examiner finds that it would have been obvious to the artisan to modify Crandall to include this feature [answer, pages 10-12]. Appellant argues that Crandall does not teach or suggest making comparisons to optimum performance parameters. Appellant also argues that the "automatic selection" in Freedman is based on the final production data and not on the information in a job quote. Appellant argues that the claimed invention contemplates a separate role for the job quote information and the actual print job specifications which is not suggested in Freedman. Appellant argues that there is no disclosure or suggestion in Crandall to enter the specification of the type of printing production equipment being used for the print job into a preference. Finally, appellant argues that the "acceptable/unacceptable" values in Crandall cannot be equated with optimum parameters as claimed [brief, pages 21-24]. The examiner responds that the acceptable values are optimum performance parameters in Crandall. The examiner also disputes each of appellant's other arguments [answer, pages 23-27]. Appellant responds that the acceptable parameters of Crandall are not optimum parameters as claimed. Appellant also repeats the argument that selection of equipment in Freedman is based on the final production data and not on the job quote as claimed [reply brief, pages 4-6].

We will not sustain the examiner's rejection of claim 14. First, we agree with appellant that the teaching of acceptable values in Crandall is not the same as outputting any actual print job specifications that are not optimum as claimed. Second, the invention of claim 14 determines which parameters have not been optimized after the job quote has been determined and the specific equipment to be used has been selected. Freedman, on the other hand, suggests selecting the optimum printing equipment based on the actual print job specifications. Thus, Freedman selects the optimum equipment to be used based on the actual print job specifications whereas the claimed invention selects the equipment as part of the job quote and then determines which parameters are not optimum based on that selection. These are two entirely different processes.

Since we have not sustained the rejection of independent claim 14, we also do not sustain the rejection of dependent claims 15 and 17-20. Independent claim 36 has recitations similar to claim 14. Therefore, we also do not sustain the rejection of independent claim 36 or of claims 37 and 39-42 which depend therefrom. With respect to dependent claims 16 and 38, which are rejected using the additional teachings of Inoue, we also do not sustain the rejection of these claims because Inoue fails to overcome the deficiencies of Crandall and Freedman discussed above.

With respect to independent claims 21 and 43, the examiner finds that Crandall

teaches the claimed invention except for using the job quote to automatically select the type of printing equipment being used. The examiner cites Freedman as teaching this feature. The examiner finds that it would have been obvious to the artisan to use the automatic selection of Freedman in the printing system of Crandall [answer, pages 14-16]. Appellant argues that the automatic selection in Freedman is based on the final production data and not on information in the job quote as claimed. Appellant's additional arguments are similar to the arguments made with respect to claims 14 and 36 [brief, pages 24-25].

We will not sustain the examiner's rejection of independent claims 21 and 43 or of claims 22 and 44 which depend therefrom. Claims 21 and 43 recite that the information in the job quote is used to automatically select the type of printing equipment to be used for the print job. As noted above, equipment selection in Freedman occurs as part of the job quote itself, and does not result from the job quote. The timing of the equipment selection in Freedman is fundamentally different from the equipment selection recited in claims 21 and 43.

In summary, we have not sustained the examiner's rejection with respect to any of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1-44 is reversed.

REVERSED

JERRY SMITH	)	
Administrative Patent Judge	)	
	)	
	)	BOARD OF PATENT
MICHAEL R. FLEMING	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
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